

## SUMMARY OF THE REJECTIONS/OBJECTIONS

The issues raised in the Final Office Action mailed on February 5, 2005 are summarized below.

Each of these issued is discussed hereinafter.

1. Claims 1-13 and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman et al., U.S. Patent No. 6,317,761 (hereinafter "Landsman"), in further view of Eillbott et al., U.S. Patent No. 6,553,393 (hereinafter "Eillbott").
2. Claims 14-15, 38-39 and 63-64 are rejected under 35 U.S.C. § 103(a) as being upatentable over Landsman, further in view of Ackermann, Jr. et al., U.S. Patent No. 6,606, 653 (hereinafter "Ackermann").
3. Claims 20, 44 and 68 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman and Eillbott in further view of Underwood, U.S. Patent No. 6,704, 873 (hereinafter "Underwood")
4. Claims 21-23, 45-47 and 69-71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman and Ellibott in further view of Markus, U.S. Patent No. 6,499, 042 (hereinafter "Markus")
5. Claims 24, 48 and 72 are rejected under 35 U.S.C. § 103(a) as being upatentable over Landsman and Ellibott in further view of Shapiro et al., U.S. Patent No. 5,991, 810 (hereinafter "Shapiro")

## THE REJECTIONS BASED ON THE PRIOR ART

### A. REJECTION OF CLAIMS 1-13 AND 16-19 UNDER 35 U.S.C. §103(a).

Claims 1-13 and 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman, further in view of Eillbott. It is respectfully submitted that Claims 1-13 and 16-19 are patentable for at least the reasons provided hereinafter.

CLAIM 1

The Office Action asserts that Landsman teaches a method, computer readable medium and computer system for allowing a porthole engine to deliver unrequested content to users that access requested content through a porthole engine. The Office Action moreover acknowledges that Landsman fails to teach the limitation further including data generated by the porthole engine. In response the Office Action relies upon Eillbott's disclosure of a proxy server to generate a list of resources to teach this limitation. The Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eillbott to use a porthole engine to generate data.

Although, Claim 1 does use a porthole engine to generate data which causes requested and unrequested content to appear on a display screen Claim 1 is limited to a very specific manner in which such content can be delivered. The limitations of Claim 1 recite the manner and sequence of events for content delivery that are not disclosed or in any way rendered obvious by Landsman either alone or in combination with Eillbott. Claim 1 recites:

receiving, from a browser executing on a client, an initial request for requested content;  
wherein said **initial request is received at said porthole engine**;  
wherein said client is connected to a network through said porthole engine;  
wherein said requested content resides on an origin server located separate from  
said porthole engine on said network; and  
**said porthole engine responding to said initial request by sending to said client** data  
generated by the porthole engine wherein the data causes said requested content  
and said unrequested content to appear on a display screen of said client.

The specific manner for content delivery recited in Claim 1 has fundamental differences to the manner described in both Landsman and Eillbot. Diagram 1 illustrates the sequences of actions for content delivery that takes place in both Landsman and Eillbot:

Diagram 1

1. Client to Proxy
2. Proxy to Web Server
3. Web Server to Proxy
4. Proxy to Client *

The only difference between the events described in Landsman and Eillbot is that at \* Step 4 Eillbot additionally discloses a translation of data by the proxy server before sending the data back to the client. Irrespective of the difference between the Landsman and Eillbot the flow of events remains the same. In both cases the proxy server communicates with and receives data from the web server before any data is sent to the client. In contrast, the sequence of events recited in Claim 1 does not involve the porthole engine communicating with the web server before data is sent to the client. Furthermore, it is only after the porthole engine sends the data to the client that any communication with the web server takes place.

Claim 1 recites “wherein said **initial request is received at said porthole engine;** ...said porthole **engine responding to said initial request** by sending to said client data generated by the porthole engine wherein the data causes said requested content and said unrequested content to appear on a display screen of said client.” This sequence of events is illustrated in Diagram 2:

Diagram 2.

1. Client to Porthole
2. Porthole to Client
3. Client to Porthole
4. Porthole to Web server
5. Web server to Porthole
6. Porthole to Client

The key distinction of Claim 1 is that the porthole engine **in response to receiving the initial request sends back to the client** data that is generated by the porthole engine. The response to the **initial request does not** involve communication with the web server. It is only after the porthole engine responds to the initial request, and sent to the client data generated by the porthole engine that retrieval of data from the web server is triggered. It is the data generated and sent to the client by the porthole engine that causes the retrieval of content from the web server. The porthole engine has the ability to distinguish an initial request from those requests that trigger retrieval from the web server. “The ability to distinguish initial requests from requests for porthole-embedded items is important because, if all requests were treated as initial requests, the porthole engine 30 would always respond by sending frame data and the user would never receive the actual content,” (Specification page 15 lines 18-21). These features recited in Claim 1 are fundamentally different than those described in Landsman and Eillbott.

A detailed example of Claim 1’s sequence of events is described in the Specification pages 14 – 16 and FIG. 3 of the application. “In step 1, a user, via a web browser, sends an initial request for <http://www.cajun-gifts.com/> to porthole engine 30. In response, porthole

engine 30 in step 2 sends back to the user frameset data. This frameset data generates an encapsulation of the original target page with panels containing the unrequested information.

The frameset data identifies <http://www.cajun-gifts.com/>, <http://some-isp.net/porthole/frame1.html>, and <http://some-isp.net/porthole/frame2.html> to be displayed in content display area 200. This frameset data also indicates how the documents <http://www.cajun-gifts.com/>, <http://some-isp.net/porthole/frame1.html>, and <http://some-isp.net/porthole/frame2.html> are to be displayed. As shown in FIG. 2, <http://www.cajun-gifts.com/>, <http://some-isp.net/porthole/frame1.html>, and <http://some-isp.net/porthole/frame2.html> are displayed in areas 204, 208-1, and 208-2, respectively.

In step 3, the browser decodes the frameset data and, upon decoding the tags for the embedded items, sends requests for <http://www.cajun-gifts.com/>, <http://some-isp.net/porthole/frame1.html>, and <http://some-isp.net/porthole/frame2.html> to porthole engine 30. In contrast to the request for <http://www.cajun-gifts.com/> issued in step 1, the request for [http://www.cajun-gifts.com](http://www.cajun-gifts.com/) in step 3 is requesting <http://www.cajun-gifts.com/> as an embedded item.”

It is evident from the above example that Landsman and Eillbott either alone or in combination do not disclose the sequence of events in the manner recited by Claim 1. Both Landsman and Eillbott do not teach or disclose the use of a proxy server in response to an initial request sending data to the client without first contacting or communication with a web server. Furthermore, neither Landsman nor Eillbott suggest that the proxy server has the ability to distinguish an initial request from other requests.

In view of the foregoing, it is respectfully submitted that Claim 1 includes one or more limitations that are not in any way expressly or inherently disclosed by Landsman, and therefore Claim 1 is patentable over Landsman.

### THE REMAINING CLAIMS

Claim 25 a “computer readable medium” version of Claim 1. Claim 49 is a system claim with limitations similar to those described above. The remaining claims depend, directly or indirectly, on Claim 1, 25 or 49. Therefore, all of the remaining claims are allowable for the reason given above with respect to Claim 1. In addition, each other claim includes one or more additional limitations that independently render it patentable over the art of record. For example:

#### CLAIM 9

Claim 9 recites “The method of Claim 1 wherein said porthole engine determines the format in which to display said requested content and said unrequested content based on one or more factors including at least one of differences in browsers, components of requested web pages, and versions of the browsers” The Office Action asserts that this feature is taught by combining Landsman’s disclosure of ad selection based on user specific information collected for and associated with the user operating browser (col. 21, lines 10-28) with Eillbott’s discloser of a proxy service to used choose and translate the format of a page (col. 5, lines 12-23). This is incorrect. First, ad selection based on user specific information (as disclosed in Landsman) does not correspond to a **content display format** (as recited in Claim 9). Ad selection refers to actual selection of an advertisement whereas the content display format of Claim 9 does not involve any actual content such as an advertisement. Instead, the content display format is information indicating display format for content which **will be retrieved at a later time**. Since The Ad selection of Landsman clearly describes the retrieval and display of actual content the Ad selection cannot possibly be Claim 9’s content display format which does not contain content.

Second, Eillbott's disclosure of format translation (col. 5, lines 12-23) is done after receiving content from the web server. In contrast Claim 9 determination of the format is done prior to receiving any content (See Diagram 2). It is an important limitation that the content display format is done prior to contacting the web server for content retrieval. Therefore, Landsman and Eillbott either taken alone or in combination do not describe determining content display format in the manner recited in Claim 9.

#### CLAIM 11

The Office Action asserts that "the porthole engine receiving a series of subsequent request from the browser **in response to the browser decoding said frame data**, said series of subsequent requests including a second request for said requested content;" is taught by Landsman (col. 8, lines 41-67) in view of Eillbott (col. 4, lines 22-63). These references taken alone or in combination do not teach the limitation recited in Claim 11. First, the text in Landsman teaches a **downloading re-start when a second request for the content is received**. The application of the downloading re-start is incompatible with the features recited in Claim 11 because Landsman's description of a downloading re-start **occurs exclusive of a first request** for the content and cannot possibly correlate to the subsequent request recited in Claim 11 which is **still related to the initial request**.

Additionally, neither Landsman nor Eillbott s describe subsequent requests which were triggered by **decoding said frame data**. The re-start described in Landsman is in response to a user requests not decoding frame data. Similarly, Eillbott does not teach or described the use of a proxy server to retrieve subsequent requests that are triggered by **decoding said frame data**. Eillbott describes the use of a proxy server to request pages from the origin server and

delivering it to the client but, does not teach or suggest that the requests are in response to decoding frame data.

Further more as described above with respect to Claim 1 the porthole engine distinguishes initial requests from the subsequence requests. This is an important distinction because it is **only** when the subsequent requests are received at the porthole engine that the web server is contacted and content retrieved. Claim 11 is in reference to these subsequent requests which were triggered by **decoding said frame data**. Therefore, since neither Landsman nor Eillbott teach or suggest the limitations of Claim 11 it is patentable over Landsman in view of Eillbott. Reconsideration is respectfully requested.

B. REJECTION OF CLAIMS 14-15, 38-39 AND 63-64 UNDER 35 U.S.C. § 103(a)

Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Ackermann. Claims 14 and 15 depend from Claim 1 and include all the limitations recited in Claim 1. As explained above, Landsman and Eillbott either taken alone or in combination do not teach one or more limitations required by Claim 1. Therefore, a combination of Ackerman with Eillbott and Landsman cannot provide all features or steps recited in Claims 14 and 15.

Claims 38-39 and 63-64 include similar limitations to Claims 14 and 15 except Claims 38 and 39 refer to a computer-readable medium and Claims 63 and 64 refer to a system. Therefore, Claims 38-39 and 63-64 are patentable over Landsman and Ackermann for at least the reasons provided herein with respect to Claims 14 and 15.

C. REJECTION OF CLAIM 20, 44 AND 68 UNDER 35 U.S.C. § 103(a)



Claims 20, 44 and 68 and were rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman and Eillbott in further view of Underwood. Claim 20 depend from Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman either alone or in combination with Eillbott does not teach one or more limitation required by Claim 1. Therefore, a combination of Underwood with Eillbott and Landsman cannot provide all features or steps recited in Claim 20. Claims 44 and 68 recite similar limitations to Claim 20, except Claim 44 relates to a computer-readable medium and Claim 68 relates to a system. In addition, Claims 20 44 and 68, introduce additional limitations that independently render them patentable over Landsman and Eillbott in view of Underwood. However, due to the fundamental differences already identified for the claim upon which Claims 20, 44 and 68 depend, a separate discussion of those limitations are not included at this time.

D. REJECTION OF CLAIMS 21-23, 45-47 AND 69-71 UNDER 35 U.S.C. § 103(a)

Claims 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman and Eillbott in further view of Markus. Claims 21-23 depend from Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman either alone or in combination with Eillbott does not teach one or more limitation required by Claim 1. Therefore, a combination of Markus with Eillbott and Landsman cannot provide all features or steps recited in Claims 21-23. Further, limitations recited in Claims 21-23 recited additional limitations not taught or suggested by Landsman and Eillbott in view of Markus either taken alone or in combination. However, due to the fundamental differences already identified for the claim upon which Claims 21-23 depend, a separate discussion of those limitations are not included at this time.

Claims 45-47 and 69-71 include similar limitations to Claims 21-23 except that Claims 45-47 refer to a computer-readable medium and Claims 69-71 refer to a system. Therefore, Claims 45-47 and 69-71 are patentable over Landsman in view of Ackermann for at least the reasons provided herein with respect to Claims 21-23.

E. REJECTION OF CLAIMS 24, 48 AND 72 UNDER 35 U.S.C. § 103(a)

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman and Eillbott in further view of Shapiro. Claim 24 depends from Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman either alone or in combination with Eillbott does not teach one or more limitation required by Claim 1. Therefore, a combination of Shapiro with Eillbott and Landsman cannot provide all features or steps recited in Claim 24. Further, limitations recited in Claim 24 recited additional limitations not taught or suggested by landsman and Eillbott in view of Shapiro either taken alone or in combination. However, due to the fundamental differences already identified for the claim upon which Claim 24 depend, a separate discussion of those limitations are not included at this time.

Claims 28 and 72 recite similar limitation to Claim 24 except that Claim 28 refers to a computer-readable medium and Claim 72 refers to a system. Therefore, Claims 28 and 72 are patentable over Landsman and Shapiro for at least the reason provided herein with respect to Claim 24.

D. REMAINING CLAIMS

The remaining pending claims not discussed so far are dependent claims that depend on an independent claim discussed above. Because each of the dependant claims includes the

limitations of the claims upon which they depend, the dependant claims are patentable for at least those reasons given above for the independent claims. Removal of the rejections with respect to the dependant claims and allowance of the dependant claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. However, due to the fundamental differences already identified for the independent claim, a separate discussion of those limitations are not included at this time.

### III. CONCLUSIONS & MISCELLANEOUS

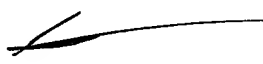
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

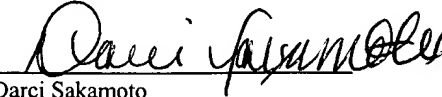
  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on April 18, 2005

by   
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